

Please enter the following amendments and remarks:

STATUS OF THE CLAIMS

Claims 1-26 are pending in the Application.

Claims 1-26 stand rejected by the Examiner.

Claims 2-10, 12 and 17 stand objected to by the Examiner.

Claims 2-12, 17 and 19 have been amended, without prejudice, herein.

REMARKS

Reconsideration of the present Application is respectfully requested.

Claim Objections

Claims 2-10, 12 and 17 have been objected to because of an insufficient antecedent basis. Specifically, the Examiner asserts these Claims recite the limitation “the step” in line 2 [claims 2-8, 10 and 12], and line 1 [claim 9]. Applicant respectfully submits Claims 2-10, 12 and 17, as amended, have proper antecedent basis and overcome the present objection.

Claim Rejections Pursuant to 35 U.S.C. 112, Second Paragraph

Claims 11 and 19 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out an distinctly claim the subject matter which applicant regards as the invention.

35 U.S.C. 112, second paragraph, states:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The present Office Action rejects Claim 11, specifically referencing the portion of the claim which states “the step of reconnecting”. The present Office Action represents this phrase leaves the claim with an indeterminate claim scope. The present Office Action also rejects Claim 19, specifically referencing the portion of the claim which states “input/output means”. The present Office Action represents this phrase is indefinite.

Applicant has amended Claims 11 and 19 to more distinctly point out and claim the present invention. Applicant thus respectfully submits that Claims 11 and 19, as amended, satisfy the requirements of 35 U.S.C. § 112.

Claim Rejections Pursuant to 35 U.S.C. §102(e)

Claim 1 has been rejected under 35 U.S.C. §102(e) as being anticipated by Qua et al. (U.S. Patent No. 6,222,909). Applicant respectfully traverses this rejection for at least the following reasons.

35 U.S.C. §102(e) recites:

A person shall be entitled to a patent unless-

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Consistently, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See, M.P.E.P. §2131 citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).*

Applicant respectfully submits the present Office Action mischaracterizes the teaching of Qua. As stated in the present Office Action, Qua discloses a mechanism that enables a user of a wireless device to store audio notes and subsequently distribute them. The system disclosed by Qua is designed for the quick recording of comments from a user, for example, to capture a user's thoughts during a conference call.

The present Office Action does not take into consideration the sequential steps of the method recited in Claim 1 when characterizing the teaching of Qua. In Qua, the user *first* records the audio note on the adjunct processor 130 (see Qua, Figure 1). After the audio note is recorded and stored, the user can subsequently forward the audio note via an email system 160 (see Qua, Figure 1). Thus, in the audio note taking system of Qua, connection to the email system via the network only occurs *after* recording of the audio note, and never before.

The present Office Action tries to correlate the "first server" of Claim 1 to the email system 160 of Qua, and the "second server" of Claim 1 to the adjunct processor 130 of Qua. Would this characterization be true, then the method of Claim 1 must have its steps inverted in order to perform in the manner disclosed in Qua. Rather, as recited in Claim 1, a connection is made to a first server prior to the recording step on the second server. Further, the step of selecting an option to send the audio file, as recited in Claim 1, also occurs prior to the recording of an audio file on the second server. Again, Qua teaches

the decision to forward an audio note and the options for doing so occurring after the recording of the audio note, and never before such recording step. Therefore, Applicant submits Qua fails to teach, or even suggest for that matter, the sequential method of Claim 1, that being the connecting to a first server and selecting an option to send the audio file before connecting to a second server for recording the audio file.

Wherefore, Applicant respectfully requests reconsideration and removal of this rejection, as Claim 1 is patentably distinguishable over the prior art of record.

Claim Rejections Pursuant to 35 U.S.C. §103

Claims 2, 4-6, 8-10, 13-14 and 16-18 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Qua (U.S. Patent No. 6,222,909) in view of Gupte et al. (U.S. Patent Application Publication No. 2001/0034225). Claim 3 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Qua and Gupte as applied to Claim 1, and in further view of Oakes et al. (U.S. Patent No. 6,205,342). Claims 7 and 11-12 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Qua and Gupte as applied to the claims above, and in further view of Gibson et al. (U.S. Patent Application Publication No. 2002/0016174). Claim 15 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Qua and Gupte as applied to the claims above, and in further view of Segur (U.S. Patent No. 6,212,550). Claims 19-23 and 25 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Qua and Gupte as applied to the claims above, and in further view of Gillig et al. (U.S. Patent No. 5,127,042). Claim 24 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Qua, Gupte and Gillig as applied to the claims above, and in further view of Uppaluru (U.S. Patent No. 5,915,001). Claim 26 has

been rejected under 35 U.S.C. 103(a) as being unpatentable over Qua, Gupte and Gillig as applied to the claims above, and in further view of Segur. Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. §103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *MPEP 706.02(j)*.

For at least the reasons set forth above, Qua fails to teach, or even suggest for that matter, each of the limitations of independent Claim 1. As Claim 1 is patentably distinguishable over the prior art of record, Applicant further submits that Claims 2-17 are similarly distinguishable over the prior art of record, at least by virtue of their ultimate dependency from a patentably distinct base Claim 1.

Claim 18 recites the connecting to an email server and selecting an option to send a voice message *before* the recording of the voice message on a voice response server. As explained above, Qua does not teach any connecting to a server before connecting to the server used for recording and storing an audio note. In fact, Applicant notes the present Office Action does not even assert this element might be present in Qua, or any of the cited references in this 35 U.S.C 103(a) rejection. Therefore, each of the references, either separately or in combination, fail to teach or suggest each of the limitations of Claim 18.

Regarding Claim 19, Applicant respectfully submits that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combinations. The Examiner must explain, by citation to proper references, the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. Simply stating that a motivation exists is not enough. *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998). In *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002), the Court of Appeals for the Federal Circuit reversed the Board's decision, stating:

" 'common knowledge and common sense' on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation..***The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.***"

MPEP §2144.03A citing *Lee* at 1344-45. (emphasis added)

Here, the Office Action has cited no support, other than its own opinion, for the combination suggested, nor has the Office Action provided an illustration that the references combined as cited would produce an email system for sending voice messages to a recipient having the characteristics recited in Claim 19. Rather, the Office Action has merely asserted what its opinion is by importing the language of Claim 19 into the cited references, followed by a conclusory statement that such a combination would be obvious. Such assertions are not grounds for a proper rejection pursuant to 35 U.S.C. 103. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

In light of the above, Applicant respectfully requests that the Examiner provide a proper teaching of motivation, other than personal stated feelings on the prior art, using specific citation to cited references that would motivate one skilled in the art to combine the cited references in a way that would make the present invention, as claimed, obvious.

Accordingly, Applicant submits at least Claim 19 is patentably distinguishable over the prior art of record. Applicant further submits that Claims 20-26 are similarly distinguishable over the prior art of record, at least by virtue of their ultimate dependency from a patentably distinct base Claim 19.

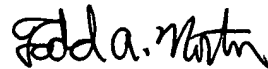
CONCLUSION

Wherefore, Applicant believes he has addressed all outstanding grounds raised by Examiner and respectfully submits that the present case is in condition for allowance, early notification of which is earnestly solicited.

Should there be any questions or outstanding matters, Examiner is cordially invited and requested to contact Applicant's undersigned attorney at his number listed below.

Respectfully Submitted,

REED SMITH LLP

A handwritten signature in cursive script, reading "Todd A. Norton", positioned above a horizontal line.

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